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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,667	09/08/2003	Marc Brian Wisnudel	129547 (1306-43)	2163

7590 09/20/2006

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EXAMINER
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ANGEBRANNDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/657,667

**Applicant(s)**

WISNUDEL ET AL.

**Examiner**

Martin J. Angebranndt

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/26/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. The response of the applicant has been read and given careful consideration. Responses to the arguments are presented after the first rejection to which they are directed. The amendment to the specification is accepted.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims language of claims 1, 24 and 25 describing the substrate as “between the reactive layer and the laser incident surface” is flawed as the substrate is the incident surface of the light in the embodiments. The applicant should amend the claims to describe the reactive layer as being between the substrate and the reflective layer. **This also would prevent the claims from being interpreted as being limited to embodiments where the backside of the substrate is coated.**

The implication of the limitation at issue, is that the substrate is **the laser incident surface**.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wisnudel et al. ‘909.

Wisnudel et al. '909 in example 2 a metallized polycarbonate substrate coated with a PMMA/leuco methylene blue solution, and then a an unmetallized polycarbonate substrate is applied via an adhesive layer. The data layer may be embossed or a separate photosensitive layer (10/26-57). The use of additives which change the oxygen permeability of the second substrate, including antiplasticizers, pigments, mold release agents, thermal stabilizers, UV absorbers and oxygen scavengers, for various other reasons is disclosed. (9/5-33). The substrate may be made from polyacrylates, including **PMMA, PMMA copolymers**, polyacrylonitrile and polystyrenes (3/62-4/21 and claim 19). The diffusion should be between 0.01 and 1.35 Barrers. (abstract)

It would have been obvious to one skilled in the art to use copolymers or polymeric blends of PMMA, which is specifically described in column 4 with other materials disclosed including styrene, acrylonitrile and acrylates so as to meet the oxygen permeability requirements, in place of the polycarbonate of the second substrate with a reasonable expectation of forming a useful optical recording medium protected in a manner similar to that achieved by using polycarbonates as in the cited example based upon the disclosure of the parameters to be optimized and the materials useful for forming the substrate.

The applicant does have data showing that **PMMA** by itself cannot meet the Barrers limitation recited. Being a physical property, which is measurable and by the addition of additives or blending with other polymers, clearly able to be varied, the teachings of the reference clearly provide direction to any of the polymer described as useful for the first and second substrate materials. It may be desirable in some instances to have the disc be unreadable after a different interval, so the data is unpersuasive.

While PMMA may not meet the limitation, the references does disclose PMMA copolymers as well as polyacrylonitrile and polystyrenes. The applicant has not shown a criticality in the composition and the mechanism for the functioning of the reactive layer is clearly appreciated in the reference, so control of the oxygen permeation through the substrate and to the reactive layer would be appreciated. As the reference is applied in the 103 rejection where the reference is available under 102(e), the applicant may wish to consider a statement that the reference and the instant application were commonly owned at the time of invention to reduce the issues.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen et al. '206, in view of Wisnudel et al. '909 and/or Abe et al. 01-290137

Olson et al. '206 in example 6 a metallized polycarbonate substrate coated with a PMMA/leuco methylene blue solution, and then a an unmetallized polycarbonate substrate is applied via an adhesive layer. The data layer may be embossed or a separate photosensitive layer [0043]. The use of additives which change the oxygen permeability of the second substrate, including antiplasticizers, pigments, mold release agents, thermal stabilizers, UV absorbers and oxygen scavengers, for various other reasons is disclosed. [0038]. The substrate may be made from polyacrylates, including PMMA, PMMA copolymers, polyacrylonitrile and polystyrenes [0024].

Abe et al. 01-290137 establishes that optical disk substrate which are copolymers of methyl methacrylate and styrene are old and well known.

It would have been obvious to one skilled in the art to use copolymers or polymeric blends of PMMA, which is specifically described in over Olsen et al. '206 with other materials

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disclosed including styrene, acrylonitrile and acrylates so as to meet the oxygen permeability required to have the medium become unreadable, in place of the polycarbonate of the second substrate with a reasonable expectation of forming a useful optical recording medium protected in a manner similar to that achieved by using polycarbonates as in the cited example based upon the disclosure of the parameters to be optimized and the materials useful for forming the substrate by Wisnudel et al. '909 and/or the disclosure of copolymers within the scope of the coverage sought being old and well known as substrate materials for optical recording.

While PMMA may not meet the limitation, the references does disclose PMMA copolymers as well as polyacrylonitrile and polystyrenes. The applicant has not shown a criticality in the composition and the mechanism for the functioning of the reactive layer is clearly appreciated in the reference, so control of the oxygen permeation through the substrate and to the reactive layer would be appreciated. As Olsen et al. '206 and Wisnudel et al. '909 are applied in the 103 rejection where the reference is available under 102(e), the applicant may wish to consider a statement that the reference and the instant application were commonly owned at the time of invention to reduce the issues.

7. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ezbiansky et al. '892, in view of Wisnudel et al. '909 and/or Abe et al. 01-290137.

Ezbiansky et al. '892 (**abandoned**) in example 5 a metallized polycarbonate substrate coated with a PMMA/leuco methylene blue solution, and then a an unmetallized polycarbonate substrate is applied via an adhesive layer. The data layer may be embossed or a separate photosensitive layer [0050]. The use of additives which change the oxygen permeability of the second substrate, including antiplasticizers, pigments, mold release agents, thermal stabilizers,

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UV absorbers and oxygen scavengers, for various other reasons is disclosed. [0045]. The substrate may be made from polyacrylates, including PMMA, PMMA copolymers, polyacrylonitrile and polystyrenes [0029].

It would have been obvious to one skilled in the art to use copolymers or polymeric blends of PMMA, which is specifically described in over Ezbiansky et al. '892 with other materials disclosed including styrene, acrylonitrile and acrylates so as to meet the oxygen permeability required to have the medium become unreadable, in place of the polycarbonate of the second substrate with a reasonable expectation of forming a useful optical recording medium protected in a manner similar to that achieved by using polycarbonates as in the cited example based upon the disclosure of the parameters to be optimized and the materials useful for forming the substrate by Wisnudel et al. '909 and/or the disclosure of copolymers within the scope of the coverage sought being old and well known as substrate materials for optical recording as evidenced by Abe et al. 01-290137.

While PMMA may not meet the limitation, the references does disclose PMMA copolymers as well as polyacrylonitrile and polystyrenes. The applicant has not shown a criticality in the composition and the mechanism for the functioning of the reactive layer is clearly appreciated in the reference, so control of the oxygen permeation through the substrate and to the reactive layer would be appreciated. As Ezbiansky et al. '892 and Wisnudel et al. '909 are applied in the 103 rejection where the reference is available under 102(e), the applicant may wish to consider a statement that the reference and the instant application were commonly owned at the time of invention to reduce the issues.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,866,909. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent embrace the subject matter of the instant claims as the structure is recited identically together with the Barrers limitation in claim 1, Claim 22 recited the reactive layer composition, claim 19 recites polystyrenes, polyacrylates, polyacrylonitrile, copolymers and polymer blends of these and claim 4 recites the additives to the substrate.

The submission of proper terminal disclaimers and addressing the common ownership should allow the case to proceed to issue.

10. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No.

10/657631 (US 20034/0152013). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent embrace the subject matter

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of the instant claims as the structure is recited identically together with the Barrers limitation in claim 21, Claim 12 recited the reactive layer composition, claim 6 recites polystyrenes, polyacrylates, polyacrylonitrile, copolymers and polymer blends of these.

11. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No.

10/385047 (US 2003/0207206) in view of Wisnudel et al. '909 and/or Abe et al. 01-290137.

The subject matter of the instant claims as the structure is recited and include language describing the limitation of replay in claim 2, Claim 12 recited the reactive layer composition, claim 9 recites polystyrenes, polyacrylates, polyacrylonitrile, copolymers and polymer blends of these and it would have been obvious to one skilled in the art to use copolymers or polymeric blends of PMMA, which is specifically described in over Olsen et al. '206 with other materials disclosed including styrene, acrylonitrile and acrylates so as to meet the oxygen permeability required to have the medium become unreadable, in place of the polycarbonate of the second substrate with a reasonable expectation of forming a useful optical recording medium protected in a manner similar to that achieved by using polycarbonates as in the cited example based upon the disclosure of the parameters to be optimized and the materials useful for forming the substrate by Wisnudel et al. '909 and/or the disclosure of copolymers within the scope of the coverage sought being old and well known as substrate materials for optical recording as evidenced by Abe et al. 01-290137.

This is a provisional obviousness-type double patenting rejection.

The rejection is correct.

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12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Martin J. Angebranndt', written over the printed name.

Martin J. Angebranndt  
Primary Examiner  
Art Unit 1756

09/15/2006